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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/091,637	03/05/2002	Kurt R. Linberg	P-8557.05	9741
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MEDTRONIC, INC. 710 MEDTRONIC PARKWAY NE MS-LC340 MINNEAPOLIS, MN 55432-5604				
			EXAMINER EVANISKO, GEORGE ROBERT	
			ART UNIT 3762	PAPER NUMBER 3
DATE MAILED: 12/29/2003				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

10/091,637

Applicant(s)

LINBERG, KURT R.

Examin r

George R Evanisko

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3762

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 March 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2 . 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 14-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 14, “a remote information station”, “wireless communications”, “a programmer”, “webtop unit”, “various clinical data and therapy”, “portals”, “at least one implantable medical device”, and “telnet protocol” are vague and inferentially included. It is unclear if the applicant is positively reciting or functionally reciting these elements. It is suggested to positively recite the elements first before they are used/connected to in the claim. In addition, it is unclear where the preamble ends and where the claim body begins since most of the inferentially included terms are before the transitional phrase “comprising”, but seem to be positively recited and used in the claim body. In addition, the claim states at the beginning it is “a wireless communications system” but then states it is in combination with the programmer in line 8 (it is unclear whether it is a combination or just the communications system). In line 4, “are delivered” and “are uploaded” are vague and make the claim incomplete since the claim has not set forth any element for delivering therapy or uploading data and since they sound more like method steps than structural limitations. In line 6, “a telemetry range” is vague and indefinite since it is a relative term and since the claim has not set forth the range. The claim is vague since it states that the station is in wireless communications with “a programmer or webtop unit”, but

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only uses the programmer in the claim body, lines 9-14. It is unclear if the webtop unit is necessary to the claim or if the unit can be used in place of the programmer. In line 9, "The" should be "the". In line 9, "utilizing" is vague since it is unclear if this is a positive recitation of an element (it is suggested to use "comprising" or "including"). In lines 10 and 11, "bi-directional communications" is vague and it is unclear if an element has been set forth in any of the data center, programmer, or medical device to receive and transmit information bi-directionally (telemetry). In line 12, "at least one implantable medical devices" lacks antecedent basis ("device"). In line 13, "having telemetric wireless communications with" is vague since it is unclear if this is an element in the medical device or a method step since the claim states "having...communications with...".

Claim 14 contains the trademark/trade name Telnet. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe a protocol for transmission of data and, accordingly, the identification/description is indefinite.

A suggested claim format is

A wireless communications system, comprising:

a remote web-based data center including wireless telemetry and a communications protocol;

an external programmer including wireless telemetry; and

at least one implantable device including wireless telemetry,

wherein the web-based data center utilizes said communications protocol to provide bi-directional....”

In claim 15, “implemented in” is vague and sounds like a method step. It is suggested to delete “implemented”. In line 4, “components” and “a data base” are inferentially included and it is unclear with what element (programmer, remote station, medical device) these elements belong to.

In claim 16, “imbedded systems” is inferentially included.

In claims 17 and 19, “database” is vague since claim 15 uses “data base”.

In claim 18, “implemented to” is vague since it is unclear if this is a positive recitation of a claimed element/function. It is suggested to use “configured”. In line 2, “non-critical information” is inferentially included. The claim is vague since it is unclear where the information is being transferred to.

In claim 19, “that is transferred” and “by uplinking” are vague since they sound like method steps rather than structural limitations. In addition, the claim is vague since it is unclear what element has the database (the programmer or medical device) and it is unclear what element is performing the transferring and uplinking.

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In claim 20, "the number of connections" lacks antecedent basis and it is unclear what "connections" relates to.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 14-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Duffin et al (5752976).

Duffin discloses the claimed invention with the remote station communicating with the programmer through satellite or cellular systems except for the remote station being a web-based station using Telnet protocol to talk with the programmer/web-based unit (claim 14), software upgrades on the programmer (claim 16), and the usage log including clock/timer data relating to the number of connections between the device and programmer (claim 20). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the

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wireless communication system as taught by Duffin, with the remote station being a web-based station using Telnet protocol to talk with the programmer/web-based unit, software upgrades on the programmer, and the usage log including data relating to the number of connections between the device and programmer since it was known in the art that wireless communication systems use: the remote station being a web-based station using Telnet protocol to talk with the programmer/web-based unit to provide an inexpensive, readily available communication system and protocol to bidirectionally transfer data; software upgrades on the programmer to allow the same programmer to be used on newer implantable devices so the programmer does not become obsolete and can be used with future devices; and the usage log including data relating to the number of connections between the device and programmer to allow a physician to determine if the programmer and medical device are communicating properly.

Conclusion

The claims are full of vague, indefinite, and inferentially included terms and phrases making the claims difficult to interpret. Upon correction of the 112 second paragraph rejections, the claims may further be rejected under 112 first and second paragraphs and/or rejected under 35 USC 102 and 103 with new art or art of record and the case be made final.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Iliff and Braun et al are two teachings of prior art of the use of Telnet and web-based systems to bidirectionally communicate between medical devices.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to George R Evanisko whose telephone number is 703 308-2612. The examiner can normally be reached on M-F 6:30-5:00.



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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Angela Sykes can be reached on 703 308-5181. The fax phone number for the organization where this application or proceeding is assigned is 703 306-4520.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308-1148.

George R Evanisko
Primary Examiner
Art Unit 3762

12/22/03

GRE
December 22, 2003